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REMARKS

The indication of allowable subject matter with respect to claims 2-15 is appreciated.

Claim 1 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Sturm et al. (US 5,260,800) in view of National Semiconductor's Video Sync Separator LM1881 data sheet, Dumont et al. (US 6,628,888) and Monti (5,557,236). The Applicant respectfully traverses this rejection for the following reason(s).

Claim 1

The rejection of claim 1 is deemed moot in view of the foregoing amendment, which incorporates language consistent with the features of the invention the Examiner has deemed to be allowable subject matter as set forth in paragraphs 5 and 6 on page 7 of Paper No. 060911.

However, original claim 1 is also deemed to be allowable over the art as follows.

Claim 1 is **defined as** a video signal processing integrated circuit for use in a video recording/reproducing apparatus, ***the video signal processing integrated circuit comprising, as a single chip . . . .***

Sturm fails to teach or suggest such a single chip video signal processing integrated circuit, and the Examiner has failed to identify where such a single chip is taught by Sturm. The National Semiconductor data sheet, Dumont and Monti fail to suggest that the video signal processing components of Sturm be disposed on a ***single chip***.

It has long been an accepted practice in the PTO to have the preamble give meaning to the claim and properly define the invention, *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F.2d 683, 16 USPQ 2d 1436, 1441 (Fed. Cir. 1990).

Clearly the preamble to Applicant's claim 1 not only defines the invention, but also gives meaning to the claim.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Additionally, claim 1 calls for, in part, *a video recording/reproducing processor for providing a video signal to be recorded on a storage medium and for reproducing a video signal recorded on said storage medium.*

Here the Examiner relies only on the teachings in Sturm, and refers to col. 3, lines 8-9.

Sturm's invention relates to video technology and to video tape duplication. More particularly, Sturm's invention relates to a system for duplication of video programs from a laser disk master to a video cassette at a speed that is a multiple of the normal playback speed of the laser disk master. See col. 1, lines 9-16.

Sturm's col. 3, lines 6-9 refer to "an apparatus and method are provided for utilizing a laser video disk master operating at twice speed for duplicating video information to be recorded in VHS format."

There is no mention in lines 8-9 of a *video recording/reproducing processor*. Considering col. 3, lines 8-9 in conjunction with all that is taught by Sturm, and in particular, col. 1, lines 9-16, there is only a teaching of a *reproducing processor*. There is no *video recording* performed by the

laser video disk master.

The Examiner errs in referring only the term *processor* and ignoring the tag word *recording/reproducing*. A claim is to be considered for **all** that is claimed. *See In re Farrow, Kimber, Cole, Miles and Griffiths*, 193 USPQ 689 (CCPA 1977), "* * * it is manifest that 'filter fluid' means 'filtered fluid' even if not written in that form."

There is no case law which authorizes the examiner to ignore the tag word to the claimed means, see *Thomas & Betts Corp. v ETC, Inc.*, 187 USPQ 553 (1975) and *Lockheed Aircraft Corporation v. United States*, 193 USPQ 449 (1977) wherein the tag word are not ignored.

Note that the claim clearly defines the *video recording/reproducing processor* as having both functions of *providing a video signal to be recorded on a storage medium* and *reproducing a video signal recorded on said storage medium.*

In Sturm, the *video recording/reproducing processor* (col. 3, lines 8-9) performs only the function of *providing a video signal to be recorded on a storage medium.*

Here the Examiner now applies Dumont's video cassette recorder/player as a basis of obviousness. However, Sturms invention is necessary for recording from a master laser video disk (that is to be played at twice it's normal playing speed) in order for the video information to be duplicated on a video cassette in VHS format.

It would make no sense to use the video cassette recorder/player of Dumont to play back the video just so it could be recorded on Sturm's video cassette. Video cassette duplication is well known in the art, and one of ordinary skill in the art would simply use a commercially available duplication device instead of modifying Sturm.

Additionally, the circuitry in Sturm's device is needed because the master laser video disk is to be played at twice it's normal playing speed. There is no teaching that Dumont's video cassette recorder/player can be played back at twice it's normal playing speed.

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *In re Wesslau,* 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965); see also *In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

Nor would it have been obvious to make Sturm's master laser video disk player capable of recording absent some teaching showing a desire or necessity for Sturm's master laser video disk to have the function of recording video.

That a prior art device could be modified to produce the claimed device does not justify an obviousness rejection unless the prior art suggested the modification's desirability. *In re Gordon,* 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Next, claim 1 calls for *a composite synchronization dividing unit for separating a composite synchronization signal from a video signal output by said video recording/reproducing processor.*

Here the Examiner Sturm's col. 7, lines 1-8, which state:

"The output of video buffer 90 is connected to the input of sync separator 92.

> Sync separator 92 may be an LM 1881 sync separator integrated circuit, available from National Semiconductor Corp. of Sunnyvale, Calif. Its function is to isolate the sync pulses from the composite video signal. The voltage waveform at the output of sync separator 92 is shown as trace "B" in FIG. 3b."

Note that Sturm's *composite synchronization dividing unit* is connected to the output of video buffer 90, and video buffer 90 has not been deemed to correspond to, and does not correspond to, the claimed *video recording/reproducing processor*.

FIG. 3a is an expanded block diagram of the write clock generator 90 shown in FIG. 2. Video buffer 90 is a component of write clock generator 90, neither of which have the functions of *providing a video signal to be recorded on a storage medium* **and** *reproducing a video signal recorded on said storage medium*.

Note also, that the video buffer 90 receives the composite video signal from FM demodulator 56 on line 72, however, the FM demodulator 56 also fails to have the functions of *providing a video signal to be recorded on a storage medium* **and** *reproducing a video signal recorded on said storage medium*.

Therefore, Sturm's *composite synchronization dividing unit* does not have the whole function of *separating a composite synchronization signal from a video signal output* ***by said video recording/reproducing processor***.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Next, claim 1 calls for *a vertical synchronization dividing unit for separating a vertical*

synchronization signal from the composite synchronization signal.

Here the Examiner notes that Sturm does not disclose such a *vertical synchronization dividing unit*, and relies on the National Semiconductor data sheet which teaches that the LM 1881 used by Sturm has separated vertical sync output in response to an input composite video signal.

Note that contrary to the Examiner's assertion, the LM1881 does not output a separated horizontal sync signal, but instead additionally outputs a composite sync signal and a burst/back porch output..

In Sturm, the burst/back porch output of sync separator 92 is applied to burst oscillator 97.

The other output of Sturm's sync separator 92 is the voltage waveform at the is shown as trace "B" in FIG. 3b.

Here it must be noted that the voltage waveform at the output of sync separator 92, shown as trace "B" in FIG. 3b, is a pulse corresponding to the position of the horizontal sync signal in signal "A" of FIG. 3b. However, the LM1881 does not output a separated horizontal sync signal, so it must be concluded that the voltage waveform at the output of sync separator 92, shown as trace "B" in FIG. 3b, is the composite sync signal. There is no circuit shown that receives this composite sync signal to separate the vertical sync signal therefrom.

Accordingly, there is no showing in Sturm that the vertical sync signal output terminal of the LM1881 is connected to any of the other components in Sturm's invention. Therefore, it is deemed that the vertical sync signal is not separated from the composite synchronization signal.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Claim 1 then calls for *a quasi vertical synchronization inserting unit for inserting a quasi vertical synchronization signal in the video signal output from said video recording/reproducing processor.*

Here the Examiner refers to Sturm's col. 3, lines 33-37. As noted above, Sturm fails to teach a *video recording/reproducing processor.*

Sturm's col. 3, lines 33-37 state:

> The demodulated 2X video information is converted to digital information by an analog to digital (A/D) converter. The 2X digital video information is then time-base corrected and drop out compensated. New sync and blanking signals in digital form are switched into or mixed with the digitized video signal and digital color-under chroma processing and digital luminance noise reduction processing are performed.

There is only mention of new digital sync and blanking signals, with no specific mention of a quasi vertical sync signal, and these digital signals are mixed with the digitized video signal.

Accordingly, these digital signals are not inserted into any video signal output from what ever component the Examiner deems to correspond to the claimed *video recording/reproducing processor*, noting that the claimed *video recording/reproducing processor* must have both the functions of *providing a video signal to be recorded on a storage medium* **and** *reproducing a video signal recorded on said storage medium.*

As the former Court of Customs and Patent Appeals held: It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *In re Wesslau,* 353 F.2d 238, 241, 147 USPQ

391, 393 (CCPA 1965); see also *In re Mercer*, 515 F.2d 1161, 1165-66, 185 USPQ 774, 778 (CCPA 1975).

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

Also, claim 1 calls for *a single pin port for outputting the vertical synchronization signal from said video signal processing integrated circuit and inputting a quasi vertical synchronization signal to said video signal processing integrated circuit.*

Here the Examiner refers to Sturms col. 12, lines 14-23 and notes that Sturm is silent with respect to a sync circuit with a bidirectional pin. Here, the Examiner refers to Monti's teaching of a single bidirectional sync signal pin.

The Examiner does not explain why such a pin would have been necessary in Sturm, nor how it would have been utilized and located in Sturm.

Further, claim 1 calls for *a switching unit for providing the vertical synchronization signal, which is input from the vertical synchronization dividing unit, to the pin port, or providing the quasi vertical synchronization signal, which is input from the pin port, to the quasi vertical synchronization inserting unit.*

The Examiner refers us to Monti's use of a switch. Note however that Monti's switch 5 does not direct input signals to nor output signals from the pin 2. Switch 5 merely functions to ground pin 2 so that a logic value of "0" is applied as a control input. When switch 5 is open it has no affect on pin 2.

Accordingly, the rejection of claim 1 is deemed to be in error and should be withdrawn.

The Examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

No fee is incurred by this Amendment.

Should a Petition for extension of time be required with the filing of this Response, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,

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